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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,855	04/06/2001	Krister Draxo	7112	8864
7590 11/25/2003			EXAMINER	
JOHNS MANVILLE INTERNATIONAL, INC. Legal Department P.O. Box 5108 Denver, CO 80217			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

**Office Action Summary**

Application No.

09/827,855

Applicant(s)

DRAXO ET AL.

Examiner

Jennifer A Boyd

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on October 30, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) 1, 4 and 11 - 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 - 3, 5 - 10 and 16 - 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. The Applicant's Amendments and Accompanying Remarks, filed October 30, 2003, have been entered and have been carefully considered. Claims 1, 7 and 9 have been amended and claims 1 – 20 are pending. Claims 1, 4 and 11 – 15 remain withdrawn from the previous Restriction Requirement. The Examiner withdraws the 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection of claims 1, 4, 7, 9 and 12 – 15 as set forth in paragraphs 3 – 5 of the previous Office Action dated September 25, 2003. In view of Applicant's statement of common ownership of Edlund (US 6,291,011), the Examiner withdraws the 35 U.S.C. 103(a) rejection of claims 2, 5, 7 – 8 and 17 – 19 as being unpatentable over Edlund (US 6,291,011) in view of Fagan (US 4,783,354) and of claims 9 – 10 as being Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund (US 6,291,011) in view of Fagan (US 4,783,354) and DeProspero et al. (US 5,639,539). Despite these advances, the invention as currently claimed is not found to be patentable for reasons herein below.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

4. Claims 3, 5 – 7, 16 – 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Andersen et al. (US 6,200,404). The details of the rejection of claims can be found in paragraph 7 of the previous Office Action dated September 25, 2003. The rejection is maintained.

***Claim Rejections - 35 USC § 103***

5. Claims 2 - 3, 5 – 10, 17 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable Draxo et al. (US 6,337,104) in view of Fagan (US 4,783,354).

Draxo is directed to a pre-glued glass fabric wallcovering (Title).

As to claim 17, Draxo teaches a glass fiber wallcovering coated on both sides with a first coating comprising an aqueous dispersion of a starch binder and a polymeric latex binder (Abstract).

As to claim 18, Draxo teaches that the starch is present in the amount of 10 – 70% by weight and the polymeric latex binder is present in the amount of 20 to 80% by weight of the dry substance (column 3, lines 15 – 25 and Table 1).

As to claim 2, Draxo teaches that the wallcovering can comprise a woven glass fabric (column 2, lines 40 – 50).

As to claim 3, Draxo teaches that the wallcovering can comprise a nonwoven glass fabric (column 2, lines 62 – 67).

As to claim 5, Draxo teaches that the first coating can comprise potato starch as the starch binder (column 3, lines 23 – 30).

As to claim 6, Draxo teaches that the first coating can comprise an acrylic latex binder as the polymeric latex binder (column 3, lines 23 – 30).

As to claim 7, Draxo teaches that the first coating can additionally comprise a cross-linking agent (column 3, lines 30 – 40).

As to claim 8, Draxo teaches that the cross-linking agent is preferably a zirconium cross-linker (column 3, lines 30 – 40).

As to claim 9, Draxo teaches that the first coating can additionally comprise a pigment (column 3, lines 43 – 48).

As to claim 10, Draxo teaches that the pigment can be titanium oxide (Example and column 5, lines 23 – 30).

As to claim 17, Draxo teaches the claimed invention except fails to teach that the second dried coating comprises a paraffin wax and a rheology modifier.

Fagan is directed to a sheet material suitable for use as wallpaper (Abstract). Fagan teaches that the sheet material can be firmly adhered to a surface, and yet readily removed therefrom, without the necessity of pre-wetting and without damaging the surface (Abstract). Fagan teaches a pressure sensitive adhesive coating comprising wax such as paraffin wax (column 4, lines 50 – 67) and a thickener, or rheology modifier (column 5, lines 36 – 45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pressure sensitive adhesive coating of Fagan as the second dried coating of

Draxo motivated by the desire to easily remove the wallpaper without damaging the application surface.

As to claim 19, Draxo in view of Fagan discloses the claimed invention except for that the paraffin wax is present in the amount ranging from 80 – 99% by weight and the rheology modifier is present in the amount ranging from about 1 to 20% by weight. It should be noted that the amount of wax and rheology modifier is a result effective variable. For example, as the amount of wax incases, the adhesive becomes less sticky and as the amount of rheology modifier increases, the adhesive becomes thicker. It would have been obvious to one having ordinary skill in the art at the time the invention was made to the paraffin wax is present in the amount ranging from 80 – 99% by weight and the rheology modifier is present in the amount ranging from about 1 to 20% by weight, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the amount of wax and rheology modifier in the adhesive to create an easily removable and viscous solution which has a high adherence strength.

### ***Response to Arguments***

6. Applicant's arguments concerning the rejection of claims 3, 5 – 7, 16 – 17 and 20 under 35 U.S.C. 102(e) as being anticipated by Andersen et al. (US 6,200,404) filed October 30, 2003 have been fully considered but they are not persuasive.

7. In response to Applicant's Arguments that the restriction requirement should be withdrawn, the Examiner respectfully argues the contrary. It is still position of the Examiner that a Restriction Requirement is necessary. The Applicant has amended claim 1 to be dependent on a product-by-process claim, however, claim 1 is not a product-by-process claim. The Examiner issued a 35 U.S.C. 112 rejection only to explain to the Applicant why the Examiner would not give weight to amended claim 1 and its depending claims. As suggested in the 35 U.S.C. 112 rejection, if the Applicant amends claim 1 to be a product-by-process claim, then the Examiner will consider claim 1 and its depending claims 4 and 12 – 15.

8. In response to Applicant's Argument that the environmentally friendly sheet of Andersen (US 6,200,404) is not equivalent to Applicant's wallcovering, the Examiner respectfully argues the contrary. It is the position of the Examiner that Applicant's Arguments with respect to the Andersen reference as being nonanalogous art is irrelevant since the prior art meets the structural and chemical limitations set forth and there is nothing on record to evidence that the prior art product could not function in the desired capacity. The burden is shifted upon the Applicant to evidence the contrary.

9. In response to Applicant's Argument that Andersen (US 6,200,404) does not teach a glass fiber fabric, the Examiner respectfully argues the contrary. According to Complete Textile Glossary, a **non-woven fabric**, in one embodiment, is an assembly of textile fibers held together by bonding with a cementing medium such as starch or latex. In Andersen, the starch-bound matrix reinforced with glass fibers (Abstract, column 23, lines 65 – 67 and column 24, lines 20 – 30) meets the "non-woven fabric" requirements as set forth by the Complete Textile Glossary.

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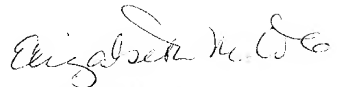
10. In response to Applicant's Arguments that the Andersen (US 6,200,404) relies heavily on "picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference", the Examiner respectfully argues the contrary. Andersen discloses each limitation required by the Applicant. Although, it may seem the Examiner relies heavily on "picking, choosing and combining", Andersen relies on selecting the preferred components depending on the desired end product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Jennifer Boyd  
November 18, 2003

  
ELIZABETH M. COLE  
PRIMARY EXAMINER